REMARKS

Applicant submits a Petition and Fee for a One-Month Extension of Time.

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further searching by the Examiner.

Claims 1-18 are all the claims presently pending in the application. Claims 1-5 have been amended to more particularly define the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-5, 9, 11, 13, 17 and 18 stand rejected under 35 U.S.C. § 102(e) as being allegedly unpatentable over Kellock et al. (U. S. Patent Pub. No. 2004/0027369). Claims 6-8, 10, 12 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kellock.

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

An exemplary aspect of the claimed invention (e.g., as recited, for example, in claim 1), is directed to an image editing apparatus which joins a plurality of images in time. The apparatus includes a recording device which records a plurality of images associated with image related information including at least one of a shooting date and time, a shooting condition, a shooting place, and a user name, a video effect recording device which records image related information associated with a video effect during image switching, a comparison device which reads first image related information about a first image recorded in the recording device and second image related information about a second image recorded in the recording device, and compares the image related information about the first and second images, a video effect selection device

which reads from the video effect recording device a video effect according to matching image related information between the image related information about the first and second images as a result of the comparison, an image joining device which reads the first and second images recorded in the recording device, and automatically joins the images by applying the video effect read by the video effect selection device to a portion in which the images are to be joined in time (Application at Figures 4 and 5; page 11, line 7-page 12, line 12), and an output device which outputs the joined images.

A conventional image editing apparatus requires a user to select a video effect to be used in joining images (Application at page 2, lines 11-31).

The claimed invention, on the other hand, may include a video effect selection device which reads from the video effect recording device a video effect according to matching image related information between the image related information about the first and second images as a result of the comparison, and an image joining device which reads the first and second images recorded in the recording device, and automatically joins the images by applying the video effect read by the video effect selection device to a portion in which the images are to be joined in time (Application at page 11, line 7-page 12, line 12). These features help to allow the claimed invention to select a video effect such that it may not be necessary for a user to set a video effect during image switching (Application at page 12, lines 9-12).

II. THE ALLEGED PRIOR ART REFERENCE

The Examiner alleges that Kellock teaches the invention of claims 1-5, 9, 11, 13, 17 and 18, and makes obvious the invention of claims 6-8, 10, 12 and 14-16. Applicant submits, however, that there are features of the claimed invention that are not taught or suggested by Kellock.

Kellock discloses an editing system in which the style of editing is controlled using style data which is optionally derived from a user (Kellock at Abstract). Specifically, Kellock discloses a process of editing input material which may include "segmentation (of video/audio), selective inclusion, sequencing, transformation and combination" (Kellock at [0017]).

However, Applicant submits that Kellock does not teach or suggest "*a video effect selection device which reads from the video effect recording device a video effect according to matching image related information between the image related information about the first and second images as a result of the comparison*" and "*an image joining device which reads the first and second images recorded in the recording device, and automatically joins the images by applying the video effect read by the video effect selection device to a portion in which the images are to be joined in time*", as recited, for example, in claim 1 (Application at Figures 4 and 5; page 11, line 7-page 12, line 12). As noted above, this feature helps to allow the claimed invention to select a video effect such that it may not be necessary for a user to set a video effect during image switching (Application at page 12, lines 9-12).

Clearly, this feature is not taught or suggested by Kellock.

Indeed, the Examiner **surprisingly** maintains that Kellock teaches or makes obvious the claimed invention. Again, the Examiner is clearly incorrect.

First, on page 3 of the Office Action, the Examiner surprisingly states that the "style information" in Kellock "would be inherently stored in a memory device". Applicant would point out that MPEP 2112 (IV) provides that **the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient** to establish the inherency of that result or characteristic. (e.g., see *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). That is, inherency, may not be established by probabilities or possibilities (e.g., see *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Further, MPEP 2112 (IV) also provides that in relying upon the theory of inherency, **the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.** (e.g., see *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

However, in this case, nowhere has the Examiner shown that it is necessary that the "style information" in Kellock is "stored in a memory device". Therefore, the Examiner has failed to provide any basis to support her assertion that the features of the claimed invention "necessarily

flow" from the teachings of Kellock. Therefore, the Examiner has failed to show that the feature is inherent.

Second, the Examiner again surprisingly attempts to equate the constructor 121 with the video effect selection device of the claimed invention. However, in the claimed invention, image related information about first and second images are compared, and the video effect selection device reads a video effect from a recording device according to matching image related information as a result of the comparison.

Nowhere does Kellock teach or suggest **comparing** image related information about first and second images. Indeed, the Examiner alleges that this feature is disclosed in Kellock in paragraph [0106], and makes the cryptic comment that "verifies that the low brightness shooting condition is satisfied by both segments". Assuming arguendo that this is disclosed in paragraph [0106] (**which it is not**), nowhere does the Examiner indicate what it is that is allegedly doing the verifying in paragraph [0106], and nowhere does the Examiner explain what "verifying a low brightness shooting condition" has to do with comparing image related information about first and second images.

Moreover, even assuming (arguendo) that Kellock teaches comparing image related information about first and second images, nowhere does Kellock teach or suggest reads a video effect from a recording device according to **matching** image related information as a result of the comparison. Again, the Examiner **surprisingly** alleges that this feature is performed by the constructor 121. However, Kellock teaches simply that the constructor stores a specification of the output production in a media scene graph (MSG) which includes a set of instructions for making the output production including source and timing of all elements of the input material and the types of transformations and special effects applied to these elements (Kellock at [0072]). Kellock teaches that "[a] central function of the constructor is to select and sequence the elements of the input material" and provides a flowchart in Figure 5 which is followed by the constructor 121 (Kellock at [0111]-[0115]).

However, nowhere in these passages or Figure 5, or any where else does Kellock teach or suggest that the constructor reads a video effect from a recording device according to **matching**

image related information as a result of comparing image related information about first and second images. Indeed, the Examiner surprisingly refers again to paragraph [0106] and attempts to support her position with another cryptic comment: "determining the use of slow dissolve transitions when the video segments to be edited satisfy a low brightness condition". However, even assuming (arguendo) that such a feature is disclosed in paragraph [0106] in Kellock (**which it is not**), Applicant submits that simply determining the use of slow dissolve transitions does not teach or suggest reading a video effect from a recording device according to **matching** image related information as a result of comparing image related information about first and second images. Indeed, the Examiner is being completely unreasonable.

Third, the Examiner **again surprisingly** attempts to equate the renderer 123 in Kellock with the image joining device of the claimed invention. This also is completely unreasonable.

Kellock simply teaches that the renderer 123 interprets Media Scene Graph (MSG) data as instructions and selects elements of the input material, applies processes such as sequencing, transformation, combination and concatenation to the selections, and transfers or copies them to an output such as a file or an audio-visual monitor (Kellock at [0075]). That is, nowhere does Kellock teach or suggest that the renderer 123 reads the first and second images recorded in the recording device, and automatically joins the images by applying the video effect read by the video effect selection device to a portion in which the images are to be joined in time.

Indeed, the Examiner attempts to support her position by referring again to paragraph [0106] in Kellock an stating "automatically (see paragraph [0090]) concatenates a first and second video segment of low brightness with slow dissolve transitions". However, even assuming (arguendo) that such a feature is disclosed in paragraph [0106] in Kellock (**which it is not**), Applicant submits that simply concatenating a first and second video segment does not teach or suggest reading first and second images recorded in a recording device, and automatically joining the images by applying a video effect read by the video effect selection device to a portion in which the images are to be joined in time.

Fourth, the Examiner **again** attempts to equate the style information in Kellock with the "video effect" of the claimed invention. Again, this is completely unreasonable.

Indeed, in Kellock, the style information is "created by a style designer, for example, by a process of manually defining a set of values for parameters, and the aim of the style designer is to create styles which will cause the system to generate high-quality output productions" (Kellock at [0096]). Kellock gives as examples of "style information", segmentation parameters, selective inclusion parameters, sequencing rules, transformation parameters and combination parameters (Kellock at [0097]-[0101]). Thus, clearly the style information in Kellock has nothing to do with the video effect in the claimed invention.

Fifth, with respect to claims 6, 8, 12 and 14-16, Applicant respectfully submits that the Examiner improperly takes official notice of the features recited in these claims.

Indeed, Applicant notes that the Examiner rejects these claims by asserting that "[o]fficial notice is taken that [the claimed feature] is well known in the art" (e.g., see Office Action at pages 7-10). However, the standard for taking Official Notice is not whether a feature is simply "well known in the art", but instead whether the feature is "capable of **instant and unquestionable** demonstration as being well-known". For example, it may be proper for an Examiner to take official notice that the boiling point of water is 100°C, or that Force=mass x acceleration.

However, the features in claims 6, 8, 12 and 14-16 are not well known like, for example, the boiling point of water. For example, claim 6 recites "wherein said plurality of images recorded in said recording device comprises an image file including at least one of a primary image of a moving picture in an image recording format, a thumbnail image for listing the primary image, and image related information about the primary image", and claim 12 recites "*a display device for displaying a list of images, wherein a user using said input device selects plural images from said displayed list of images to be edited*".

Applicant respectfully submits that the alleged facts of which the Examiner attempts to take Official Notice are **not capable of instant and unquestionable** demonstration as being well-known. Indeed, Applicant would point out if the Examiner could take Official Notice of these features, the Examiner could take Official Notice of about 90% of all claimed subject matter.

Therefore, it is clearly not appropriate for the Examiner to attempt to take "Official Notice" of these alleged facts (e.g., see MPEP §2144.03). Further, the Examiner must provide Applicant with the explicit basis on which the Examiner regards the matter as subject to Official Notice. Moreover, Applicant would point out to the Examiner that in response to Applicant's traversal of the Examiner's assertion of such "Official Notice", **the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained**.

Therefore, Applicant submits that there are features of the claimed invention that are not taught or suggested by Kellock. Therefore, the Examiner is respectfully requested to withdraw this rejection.

IV. FORMAL MATTERS AND CONCLUSION

Applicant notes that the claim 12 has been amended to address the Examiner's objections thereto.

In view of the foregoing, Applicant submits that claims 1-18, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 12/10/07

Phillip E. Miller, Esq.
Registration No. 46,060

McGinn IP Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Wanda M. Negron, Group Art Unit # 2622 at fax number (571) 273-8300 this 10th day of December, 2007.

Phillip E. Miller
Reg. No. 46,060